

### REMARKS

Claims 1 to 9, 11 to 15, 17 to 19, 21, 23 to 32, 35 to 39, 41 to 43, 46 and 48 are pending, of which Claims 1, 11, 21, 24, 35 and 46 are independent. Claims 21 and 46 are being amended. Reconsideration and further examination are respectfully requested.

Claims 21, 23, 46 and 48 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Office Action cites the description of the present application commencing at the bottom of page 7 of the specification of the application, and suggests that “the server may be implemented strictly in software.” The Office Action then contends that there is “no structure in the claim that allows the apparatus to be realized.” The Applicant respectfully points out that the cited portion of the specification describes that software, such as the Java servlet mentioned in the cited portion, runs on a computing device, such as a server. The Applicant further respectfully refers to page 13, lines 18 to 21 and page 22, lines 11 to 17, which describe that threads of execution can be run, and that such threads of execution can be run in parallel. As is amply described in the present application, a computing device, such as the claimed server, executes code to provide functionality. Without conceding the correctness of the rejection, Claims 21 and 46 are amended to even more clearly recite structure in the form of at least one server that executes code. It is respectfully submitted that Claims 21, 23, 46 and 48 recite statutory subject matter. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 1 to 3, 5 to 7, 11 to 15, 17, 18, 21, 24 to 26, 28 to 30, 35 to 39, 41, 42 and 46 are rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,438,579 (Hosken or “the Hosken patent”), and Claims 4, 8, 9, 19, 23, 27, 31, 32, 43 and 48 are rejected under 35 U.S.C. § 103(a) over Hosken. Reconsideration and withdrawal of the rejections are respectfully requested.

The Hosken patent has a filing date of July 14, 2000, which postdates the November 10, 1999 filing date of the present application. In order for the Hosken patent to be prior art to the present invention, it is necessary to rely on a provisional patent application, U.S. Provisional No. 60/144,377 (the Hosken provisional). As a prerequisite to reliance on the Hosken provisional to establish a prior date for the Hosken patent, a showing must be made that the portions of the Hosken patent cited in rejecting the claims of the present application are fully supported by the

Hosken provisional. Reference is respectfully made to MPEP § 2136.03(III), which states in relevant part:

"[t]he 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions >if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.<" (Emphasis in original.)

The first paragraph of 35 U.S.C. 112 referenced in MPEP § 2136.03(III) states:

"[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

In order for the Hosken patent to be asserted as prior art to the claims of the present application, the Examiner must first establish that each portion of the Hosken patent relied on by the Examiner to reject the claims of the present application is supported by a written description in the Hosken provisional that satisfies § 112, first paragraph, i.e., there must be a showing that the Hosken provisional describes the cited portions of the Hosken patent in such full, clear, concise, and exact terms as to enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and that the Hosken provisional further satisfies the enablement and best mode requirements set forth in § 112, first paragraph with respect to the portions of the Hosken patent cited.

As is clear from the record, the Hosken patent was filed after the filing date of the present application, and the Hosken patent can only be prior art if it is entitled to the benefit of the filing

date of the Hosken provisional. Since there has been no showing that the Hosken provisional provides § 112, first paragraph support, i.e., support which satisfies the written description, enablement and best mode requirements, for the portions of Hosken '579 relied upon to reject the claims of the present application, the Hosken patent cannot be used as prior art against the claims of the present application. The rejection based on the Hosken patent should be withdrawn. Furthermore, should the Examiner assert the Hosken patent as prior art in another action, such action should be made non-final and should include a showing, in accordance with 35 U.S.C. § 112, first paragraph and MPEP § 2136.03(III) that each portion of the Hosken patent relied upon in making a rejection is fully supported by providing specific references to those portions of the Hosken provisional that the Examiner considers supports the portion of the Hosken patent that is being asserted against the claims of the present application.

While it is not, and cannot be, applied against the claims of the present application, the Applicant submits that the Hosken provisional fails to teach, suggest or disclose the subject matter of the claims of the present application. The Hosken provisional is directed to displaying a list of recommendations to a user of a content acquisition system, which allows the user to purchase one or more content items. The recommendations are not the content items themselves, but are merely a listing of recommended content items, and the user is free to select from the listing one or more of the recommended content items, or any other content item that is not identified in the listing, for purchase. The Hosken provisional describes an on-demand system and a mechanism for making recommendations to assist the user in the user's on-demand selection of content. The Hosken provisional does not relate in any way to an Internet radio station, or selecting at least one data stream for broadcast over a computer network as an Internet radio station, let alone a selection method used to create a playlist of data streams for broadcast via the Internet radio station, such selection method being influenced by an individual user's preferences for data streams to be broadcast but not controlled by the individual user's input so as to prevent an on-demand broadcast of data streams to the user.

In view of the foregoing, the § 102(e) and a §103(a) rejections of the claims should be withdrawn, for at least the reason that there has been no showing that the Hosken patent is prior art to the claims of the present application. Furthermore and for at least the foregoing reasons, Claim 1 and the claims that depend from Claim 1 are believed to be in condition for allowance.

Claims 11, 21, 24, 35 and 46 and the claims that depend from Claims 11, 21, 24, 35 and 46 are also believed to be in condition for allowance for at least the same reasons.

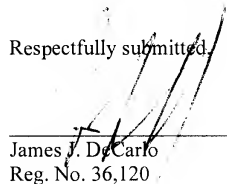
Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

The applicant's attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address associated with Customer Number 76058.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,

Date: April 3, 2008

  
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